

REMARKS

By the above amendment, claim 1 has been amended to further recite features of the present invention that the disk holder includes a pair of resilient and deformable disk holding members 10a and 10b, as illustrated in Fig. 2 of the drawings, for example, which engage the outer periphery of the disk-shaped recording medium 4. Also, a new dependent claim 5 has been presented which recite the feature that the pair of resilient and deformable disk holding members engaged the outer periphery of the disk-shaped recording medium when the disk holder is detached outside of the disk cartridge, as illustrated in Fig. 2, for example.

The rejection of claims 1 and 2 under 35 USC 102(b) as being anticipated by Yoshida et al (US 5,715,233) and the rejection of claims 2 - 4 under 35 USC 103(a) as being unpatentable over Yoshida et al, in view of Haruna (US 5,048,008), such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In accordance with the present invention, as illustrated in Figs. 1 and 2 of the drawings of this application, for example, a disk cartridge 301a is installed with an opening portion through which a recording and/or reproducing device makes access to a disk 4 for recording and/or reproducing, and a disk holder 5, which holds the disk 4, can be detached from the disk cartridge 301a or disk cartridge main body 1a thereof. The disk holder 5 includes resilient and deformable holder arms 10a and 10b for holding the disk 4 where the holder and disk are detached outside of the main body, and in a state in which the disk holder 5 is attached to the disk cartridge main body 1a, the holder arms 10a and 10b are brought into contact with arm regulating members 11a and 11b of the disk cartridge main body, and are elastically

deformed in a direction of releasing the holding state of the disk 4, so that the holder arms 10a and 10b do not engage the outer periphery of the disk 4. By the present amendment, claim 1 has been amended to recite the feature of the pair of resilient and deformable disk holding members which engage an outer periphery of the disk-shaped recording medium.

Turning to the rejection of claims 1 and 2 under 35 USC 102(b) as being anticipated by Yoshida et al, while the Examiner refers to a "disk cartridge 130" incorporating the disk shaped recording medium 31, the specification of Yoshida et al describes 130 as "a cartridge adapter" which accommodates "a cartridge 3" (emphasis added) therein, which cartridge 3 of Yoshida et al, as illustrated in Fig. 1 and subsequent figures holds the disk-shaped recording medium 31 therein, and is insertable into and attachable to the disk cartridge adapter 130. Furthermore, while the Examiner refers to an opening portion 25 and a shutter 26, such members represent part of the cartridge 3, and not the cartridge adapter 130 referred to by the Examiner. That is, column 9, lines 15 - 20 of Yoshida et al provide that the second cartridge 3 includes an opening 25 through which a reproducing or recording and reproducing head and the disk driving mechanism of the disk apparatus are inserted, a shutter 26 for opening and closing the opening 25 ..." (emphasis added). While the cartridge adapter 130 including a housing 1 having a receptacle portion 2 for accommodating the cartridge 3 and an opening 4, the cartridge adapter 130 does not have a shutter which closes the opening portion thereof when the disk cartridge is outside of the recording and/or reproducing device. Thus, it is apparent that Yoshida et al fails to provide the claimed features as originally set forth in claims 1 and 2 in the sense of 35 USC 102. Furthermore, it is readily apparent that Yoshida et al does not disclose that the disk holder includes a pair of resilient and deformable disk

holding members which engage an outer periphery of the disk-shaped recording medium, as now recited in claim 1, such that applicants submit that claim 1, as amended, patentably distinguishes over Yoshida et al in the sense of 35 USC 102 and 35 USC 103 and claim 1 and the dependent claims should be considered allowable thereover.

With respect to the combination of Yoshida and Haruna, applicants submit that irrespective of the Examiner's contentions, Haruna does not overcome the deficiencies of Yoshida et al, as pointed out above. Accordingly, applicants submit that claim 1 and the dependent claims patentably distinguish over this proposed combination of references in the sense of 35 USC 103 and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application patentably distinguish over the cited art and should now be in condition for allowance. Accordingly, issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 520.36852CC7), and please credit any excess fees to such deposit account.

Respectfully submitted,

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